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09/827,431	04/06/2001	Imaddin Othman Albazz	CA920000034US1	6091

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/827,431
Filing Date: April 06, 2001
Appellant(s): ALBAZZ ET AL.

Wayne P. Bailey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/09/2008 appealing from the Office action mailed 07/11/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Pat. No. 5,692,206   Shirley et al.   11/1997

US PG Pub 2004/0054606   Broerman Vincent S.   03/2004

(9) Grounds of Rejection

NOTE

Clarification of the status of claims 2 and 3 is provided below.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14, 16, 20-27, and 29-35 are rejected under 35 U.S.C. 102 (b) as being anticipated by Shirley, Robert Bryce et al. (U.S. Pat. No. 5,692,206).

As per claims 1-14, 16, 20-27, and 29-35 Shirley discloses a method for automating the generation of various legal documents related to a negotiated agreement, comprising:

A computer for storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract (real estate contract), storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules, generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and interlocking the compilation of business rules, the terms and conditions set and the links to

lock the lock (see., fig 8, col 1-col 12). Applicant should note that the step of closing the real

estate transaction also includes signing (or digital signature or interlocking) all the documents.

As per claims 2 and 3, Shirley discloses the claimed limitations of generating a list of a specified

subset of products from a master list of products, and generates links between the product list

filter, the terms and conditions set and the master list of products and the product list filter

comprises a plurality of tiers, each tier generating a list of a different subset of product (see., col

6-col 7, col 9-col 12, specifically at process block 604, a user selects the type of contract that will

be generated, for example, the contract may be a ground lease, a real estate purchase, a space

lease, or a shopping center lease).

> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an
> application for patent by another filed in the United States before the invention by the applicant for patent, except
> that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes
> of this subsection of an application filed in the United States only if the international application designated the
> United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 16, 20-27 and 29-35 are rejected under 35 U.S.C. 102 (e) as being

anticipated by Broerman, Vincent S. US 2004/0054606 A1 **(continuation application**

09/362,107, filed on July 07, 1999).

In regard to claims 1-14, 16, 20-27 and 29-35, it is the Examiner's principle position that the

cited reference (Broerman) discloses a real estate computer network 10 that facilitates a real

estate transaction between a buyer and a seller by electronically communicating between the

parties 12, 13 and third parties such as a real estate facilitating entities 24 (e.g., lawyer, mortgage

provider, title provider) over a network, comprising:

A computer for storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract (real estate contract), storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules, generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and interlocking (or digital signature during closing) the compilation of business rules, the terms and conditions set and the links to lock the lock (see., fig 8, col 1-col 12). Applicant should note that the step of closing the real estate transaction also includes signing (or digital signature, see paragraph [0042] or interlocking) all the documents see., figs 4, 5, 5C, 6 and 7, paragraph [0042]-[0051].

As per claim 6, Broerman discloses the claimed limitation in which the contract is locked by the implementation of digital signatures (see., paragraph [0042).

(10) Response to Argument

In regard to Applicant's arguments filed on 02/25/2008, Applicant continues to argue that the cited reference Shirley 206" does not teach the contract is locked by interlocking (i) the compilation of business rules, (ii) the terms and conditions set and (iii) the link. As described above, it is the Examiner's principal position that Shirley discloses a real estate transaction in which signing (or digital signature or interlocking) of all the documents are required. Furthermore Shirley discloses a legal advisor for providing corporate-supplied information and guidance to individual negotiators, to assist the negotiators in reaching and documenting an

agreement with an opposing party. Therefore, the legal advisor of Shirley is responsible for

revising legal documents, including proper signature (s) or interlocking of each and every

participants of the transaction. .

As per the limitation terms and conditions. It is the Examiner believes that Shirley discloses this

limitation in col 1, lines 64-67, col 7, lines 23-34, col 9-col 12, specifically financial terms.

As per claims 2 and 3, Applicant argues that the cited references (Shirley and Broerman) fail to

disclose "stores at least one product list filter for generating a list of a specified subset of

products from a master list of products, and generating links". However, the Examiner

respectfully disagrees with this assertion since Shirley discloses this limitation in col 6-col 7, col

9-col 12, specifically at process block 604, a user selects the type of contract that will be

generated, for example, the contract may be a ground lease, a real estate purchase, a space lease,

or a shopping center lease. Therefore, the product lists of Applicant's claimed invention is

readable as a ground lease, a real estate purchase as described above.

As per claim 14, Applicant also maintains that the cited references fail to disclose "conducting a

contractual activity over a computer network". As noted above, Shirley discloses this limitation

in col 1-col 12, specifically wherein said a contract generation system for generating a various

legal documents related to a negotiated agreement. Shirley further mentions that many computers

can be implemented, see., Shirley, user interface 106, fig 1.

Applicant further argues that the cited references fail to disclose the process of interlocking the

contract. As indicated above, the step of closing the real estate transaction also includes signing

(or digital signature, see paragraph [0042] or interlocking) all the documents see., figs 4, 5, 5C, 6

and 7, paragraph [0042]-[0051].

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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